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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/887,680 07/03/97 POWELL

M 82225.P0189R

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LM21/0107

EXAMINER

ENG, D

ART UNIT	PAPER NUMBER
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2783

DATE MAILED:

01/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 08/887,680	Applicant(s) Powell et al.
Examiner David Y. Eng	Group Art Unit 2783



Responsive to communication(s) filed on Oct 21, 1997

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-38 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-16 is/are allowed.

Claim(s) 17-38 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_.  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit:

Requester submitted a declaration on December 19, 1997 which includes a signature of Mr. Kenneth Olsen as one of the inventors. However, the record indicates that Mr. Kenneth Olsen is not one of the inventors in US patent 5,430,864. Clarification is requested.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

The amendment filed October 21, 1997 proposes amendments to claim 33 that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application (the entire claim 33 must be underlined) is required. In the interest of expedite the prosecution, all active claims, including claim 33, are examined.

Claims 17-38 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The prosecution of parent application (paper # 20, filed October 11, 1994, applicants' preliminary amendment in 08//321,459) indicates that applicants rely on the limitations of 1. setting the indication at the most significatn bit of the stack pointer register and 2. setting a width indication bit (the last paragraph of independent claims) for patentability. Deleting the ~~setting~~ step

Art Unit:

(claim 33-38) and/or reciting the least significant bit instead of the most significant bit is being tested amounts to recapture the scope of cancelled claims 55-72 of parent application because the combined scope of claims 1-38 can be interpreted as that the bit being tested can be set at any bit position within the stack pointer register. Note that the finally rejected and cancelled claims 55-72 fail to specify which bit of the stack pointer register is tested and do not have the setting step.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

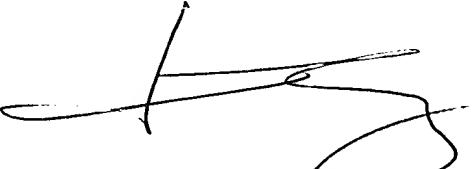
Claims 17-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for context switching by setting an indication at the most significant bit of a stack pointer register, does not reasonably provide enablement for context switching by setting an indication at the least significant bit of a stack pointer register. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification clearly discloses that the bit used for indicating word size has to be the most significant bit of the stack pointer register. See lines 25 and 37 of column 7. Further, the specification fails to disclose that the bit can be the least significant bit of the stack pointer register as claimed and how other steps have to be modified in order to accommodate this change.

Art Unit:

Without the disclosure, one of ordinary skill in the art would not be able to make and use the invention as claimed.

Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: setting a width indication bit. The step is essential because otherwise there is no indication of a second word size in the first stack save area of the memory.



DAVID Y. ENG  
PRIMARY EXAMINER